REMARKS/ARGUMENTS

Claim Rejections Under 35 U.S.C. §112

The Examiner rejected claims 1-4, 6-10, 12, and 13 for being indefinite and failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 1 has been amended to include "associated" in the preamble. Claim 3 has been amended to delete the duplicate verbiage. Claim 2 has been amended to refer to underwriting insurance, as has claim 8.

Claim Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 1-3, 6-9, 12, and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,035,276 to Newman ("Newman") in view of Turner, *Bexar, Medical Society Taking Credentialing Unit National* ("Bexar").

Claim 1

Prima facie case of obviousness not established--Through the decisions of the CCPA and the Court of Appeals for the Federal Circuit, certain well-established principles of claim construction and review have been developed. If these principles are not met, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established and the claim in issue should be allowed. The undersigned respectfully suggests that these tests are not met by the prior art in this case and a prima facie case of obviousness has not been established. These tests will be briefly applied to the individual claims rejected by the proposed combination.

There must be basis for the combination--The references themselves must suggest the combination proposed in the Office Action. The Examiner states that, "the Examiner interprets the initial universal application form, completed by a physician desiring to use the system, to be a form of 'release' as recited in the claim." There is no suggestion in Newman that the universal application is a release, and in particular, no suggestion that the application is a release of information for the purpose of underwriting or renewing liability insurance, as recited in Amended claim 1. Assuming that the application in Newman could be considered a release, it would only be a release for credentialing purposes, not for purposes of underwriting insurance. Also, there is a vast difference between obtaining a release from a healthcare provider to provide information to a credentialing organization to perform credentialing and obtaining a release from a healthcare provider to provide the same or similar information for the purposes of underwriting liability insurance. A physician filling out a credentialing form to be provided to a credentialing organization would not assume that he is also providing a release for that information to be provided to an insurance company to provide a quote for liability insurance.

With respect to the Bexar reference, there is no mention in the reference of using information from a credentialing application to underwrite insurance, as recited in amended claim 1. The Bexar reference makes it clear that the purpose behind the organization is to simplify the credentialing process, not to create a cross-over between credentialing and liability insurance underwriting. Also, the mere recognition that there is an overlap of information between credentialing application and insurance applications does not propose or suggest the solution to the problem. In fact, since people have recognized the problem for quite some time, and no one, other than the inventor of the present invention, has been able to provide a solution

to the problem shows that there is no suggestion to combine the references, or even that the combined references would teach the present invention.

The credentialing application is an application that a healthcare professional, or physician, must fill out in order to be privileged to admit patients to a particular hospital or to be approved to be on a provider panel for a given ~~managed care organization~~ health plan. This application is merely to ensure that the physician meets the requirements of the hospital for staff privileges. The credentialing application is not used for any insurance underwriting purposes. On the other hand, the malpractice insurance is used in the event that the physician or hospital is held liable for malpractice. The Newman patent deals strictly with the use of information on a credentialing application, and a transference of information from a credentialing application to another credentialing application. Also, a credentialing application is *not* an insurance application. The insurance industry is clearly divided into two separate categories - life ~~and~~ & health, and property ~~and~~ & casualty. Medical malpractice insurance is property and casualty insurance, while, if credentialing were associated with a particular type of insurance, it would be life and health. Insurance agents are licensed to sell different types of insurance, and it is not uncommon for an agent to be licensed to sell life ~~and~~ & health, but not property ~~and~~ & casualty. Therefore, even within the insurance field, there is a clear distinction. Therefore, there is no suggestion in either reference of the combination proposed in the Office Action.

All claim limitations must be considered--35 U.S.C. § 103 requires that the subject matter as a whole be reviewed. There are certain limitations of claim 1 which are still not shown in the combination proposed by the Examiner. For example, the references do not show

"obtaining a release of the associated credentialing information, between recredentialing periods, from the associated healthcare provider for the purpose of underwriting or renewing liability insurance; updating the associated credentialing information with new information for the purpose of underwriting or renewing liability insurance; or evaluating the new information for the purpose of underwriting or renewing liability insurance," as recited in claim 1. Neither Newman nor Bexar make any reference to utilizing updated credentialing information to underwrite or renew liability insurance. According to 35 U.S.C. § 103, it must be considered and given proper weight if the correct result is to be reached.

Claim 8

Prima facie case of obviousness not established--Through the decisions of the CCPA and the Court of Appeals for the Federal Circuit, certain well-established principles of claim construction and review have been developed. If these principles are not met, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established and the claim in issue should be allowed. The undersigned respectfully suggests that these tests are not met by the prior art in this case and a prima facie case of obviousness has not been established. These tests will be briefly applied to the individual claims rejected by the proposed combination.

There must be basis for the combination--The references themselves must suggest the combination proposed in the Office Action. The Examiner states that, "claims 8-9 and 12-13 recited substantially similar apparatus limitations to method claims 2-3 and 6-7 and, as such, are rejected for similar reasons given above."

The arguments given above related to claim 1 are applicable to claims 2-3, 6-9, 12, and 13, and are hereby incorporate herein by reference.

The Examiner rejects claims 4, 5, 10, and 11 under 35 U.S.C. §103(a) as being unpatentable over Newman in view of Bexar and further in view of Business Wire, *PHICO Capital Markets Debuts On-line Insurance Quotes for Physician Malpractice Coverage* ("PHICO").

Claim 4

There must be basis for the combination--The references themselves must suggest the combination proposed in the Office Action. The Examiner states that, "PHICO teaches generating an insurance premium quote for medical malpractice insurance. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the combined system of Newman and Bexar." The credentialing application is an application that a healthcare professional, or physician, must fill out in order to be privileged to admit patients to a particular hospital or to be approved to be on a provider panel for a given ~~managed care organization~~ health plan. This application is merely to ensure that the physician meets the requirements of the hospital for staff privileges. The credentialing application is not used for any insurance underwriting purposes. On the other hand, the malpractice insurance is used in the event that the physician or hospital is held liable for malpractice. The Newman patent deals strictly with the use of information on a credentialing application, and a transference

of information from a credentialing application to another credentialing application. Also, a credentialing application is *not* an insurance application. The insurance industry is clearly divided into two separate categories - life ~~and~~ & health, and property ~~and~~ & casualty. Medical malpractice insurance is property and casualty insurance, while, if credentialing were associated with a particular type of insurance, it would be ~~life and~~ health insurance. Insurance agents are licensed to sell different types of insurance, and it is not uncommon for an agent to be licensed to sell life and health, but not property and casualty. Therefore, even within the insurance field, there is a clear distinction. There is no suggestion in the industry to combine credentialing information in a liability insurance application. In fact, both the Bexar and PHICO situations have been around for seven years, and to date no one has proposed or practiced the present invention. If the combination was obvious, someone would have begun doing this process by now, given the amount of money to be made. Therefore, there is no suggestion in the references of the combination proposed in the Office Action.

CONCLUSION

Claims 1-4 and 8-10 have been amended, and new claims 14-19 have been added to the application. The undersigned believes that the application is condition for allowance.

Respectfully submitted,

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